

REMARKS

The indication that claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is acknowledged. Applicants note that by the present amendment, claim 2 has been amended in a manner similar to that suggested by the Examiner so as to overcome the informalities noted, but such claim and therewith dependent claim 3 have been retained in dependent form.

By the above amendment, informalities in the specification and abstract have been corrected, claim 1 has been amended to clarify features of the present invention, claim 2 has been amended, and claim 4 has been canceled without prejudice or disclaimer of the subject matter thereof. Dependent claims 5 and 7 being amended to depend from any one of claims 1 - 3. Additionally, new dependent claims 9 - 14 have been presented reciting features as will be discussed below.

With respect to the objection to the drawings, submitted herewith are replacement drawings in which Figures 2 and 3 have been labeled as "Prior Art" such that the objection to the drawings should now be overcome. Accordingly, acceptance of the drawings is requested.

With regard to the ~~Examiner's~~ comments as to an Information Disclosure Statement filed 07/10/03, applicants note that such documents and listing were filed under 37 CFR 1.56 and in order to provide a proper listing, submitted herewith is a PTO Equivalent Form 1449 listing such documents. Although the Examiner has rejected claims over Applicant's Admitted Prior Art (AAPA) applicants submit that such necessary represents consideration of the documents submitted.

As to the rejection of claims 1 and 4 under 35 USC 112, second paragraph, by the present amendment, claim 1 has been amended to delete the limitation considered indefinite by the Examiner while reciting a further limitation, as will be discussed below, such that applicants submit that claim 1, as amended should be considered to be in compliance with 35 USC 112, second paragraph. Claim 4 has been canceled such that the rejection with respect thereto should be obviated.

As to the rejection of claims 1 and 4 - 8 under 35 USC 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Yoshida (US 6,393,092), this rejection is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an

obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

As recognized by the Examiner, "AAPA" does not explicitly disclose a transparent means optically connected to a light output surface of a scintillator and a corresponding photoelectric means". Furthermore, by the present amendment, claim 1 has been amended to recite the feature that "in at least one of said transparent means, an area of the light output surface thereof which is optically connected to said photoelectric means is smaller than an area than a light input surface thereof upon which light from said scintillator is incident". Applicants note that the aforementioned feature is described at page 24, lines 24 - 28 of the specification in conjunction with Figure 7 of the drawings of this application, wherein the transparent means 121-1-1-2, as illustrated, is configured so that the output surface 211 thereof which provides light to the photoelectric means 114-1-1-2 is smaller than that of an area of the input surface 210 upon which light is incident from the scintillator 112-1-

1-2. As is apparent, this configuration differs from that of adjacent transparent means 112-1-1-1 and 112-2-1-3, for example. It is readily apparent that AAPA also fails to disclose such features as now recited in claim 1 and claim 1 and therewith the dependent claims patentably distinguish over AAPA in the sense of 35 USC 103.

With respect to Yoshida and the suggested combination with AAPA, applicants note that Yoshida discloses an adhesive layer 4 which serves as an optical coupler, but does not disclose or teach in the sense of 35 USC 103 that in at least one of the transparent means, which is optically connected to a light output surface of the scintillator transmitting an output light from the scintillator located integrally in a two-dimensional manner via optical reflecting means in first and second directions to photoelectric means, as recited in claim 1, "an area of the light output surface thereof which is optically connected to said photoelectric-means is smaller than a light input surface thereof upon which light from said scintillator is incident". Thus, applicants submit that Yoshida, even if combined with AAPA does not provide the recited features of claim 1, as amended, and therewith the dependent claims in the sense of 35 USC 103. As such, applicants submit that claim 1 and the dependent claim patentably distinguish over this proposed combination in the sense of 35 USC 103 and should be considered allowable thereover.

With respect to the dependent claims, applicants submit that the dependent claims, when considered in conjunction with the parent claims, recite further features which patentably distinguish over the cited art. For example, new dependent claims 9 and 10 which depend from claim 1 recite the feature that the adjacent surface of the at least one transparent means is a linear surface, as illustrated in Fig. 7, or is a non-linear surface as illustrated in Fig. 15 of the drawings of this application. Again, such features are not disclosed in the cited art.

Applicants note that by the present amendment, a new dependent claim 11 corresponding somewhat to the features as previously recited in claim 2 has been presented. Reference is made to the attached sketch, corresponding to a portion of Figures 7 and 15, respectively, showing a different angular relation which corresponds generally to the angle θ of Fig. 7 wherein an angle is defined as being between a vector extending from a surface adjacent the light input surface and a vector extending from the light input surface, generally indicated as the angle α in the attached sketch and having a relationship that the angle is at least 45° and not greater than 90° . Thus, applicants submit that claim 11, as presented, recites features corresponding to that of claim 2 and dependent claims 12 and 13 recite the adjacent surface as being a linear surface or a non-linear surface, as shown in the attached sketch. As is apparent, such claims further patentably distinguish over the cited art and should be considered allowable.

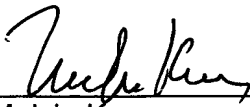
In view of the above amendments and remarks, as well as the submission of replacement sheets for Figs. 2 and 3, applicants submit that this application should now be in condition for allowance and issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli,

Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 520.42928X00),
and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in cursive script, appearing to read 'Melvin Kraus', is written over a horizontal line.

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Attachments

Amendments to the Drawings:

The attached sheets of drawings include changes to Figs. 2 and 3. These sheets, which include Figs. 2 and 3, replace the original sheets including Figs. 2 and 3. These figures have been amended to include the legend "Prior Art".

Attachment: Replacement Sheets
 Annotated Sheets



FIG. 2 (PRIOR ART)

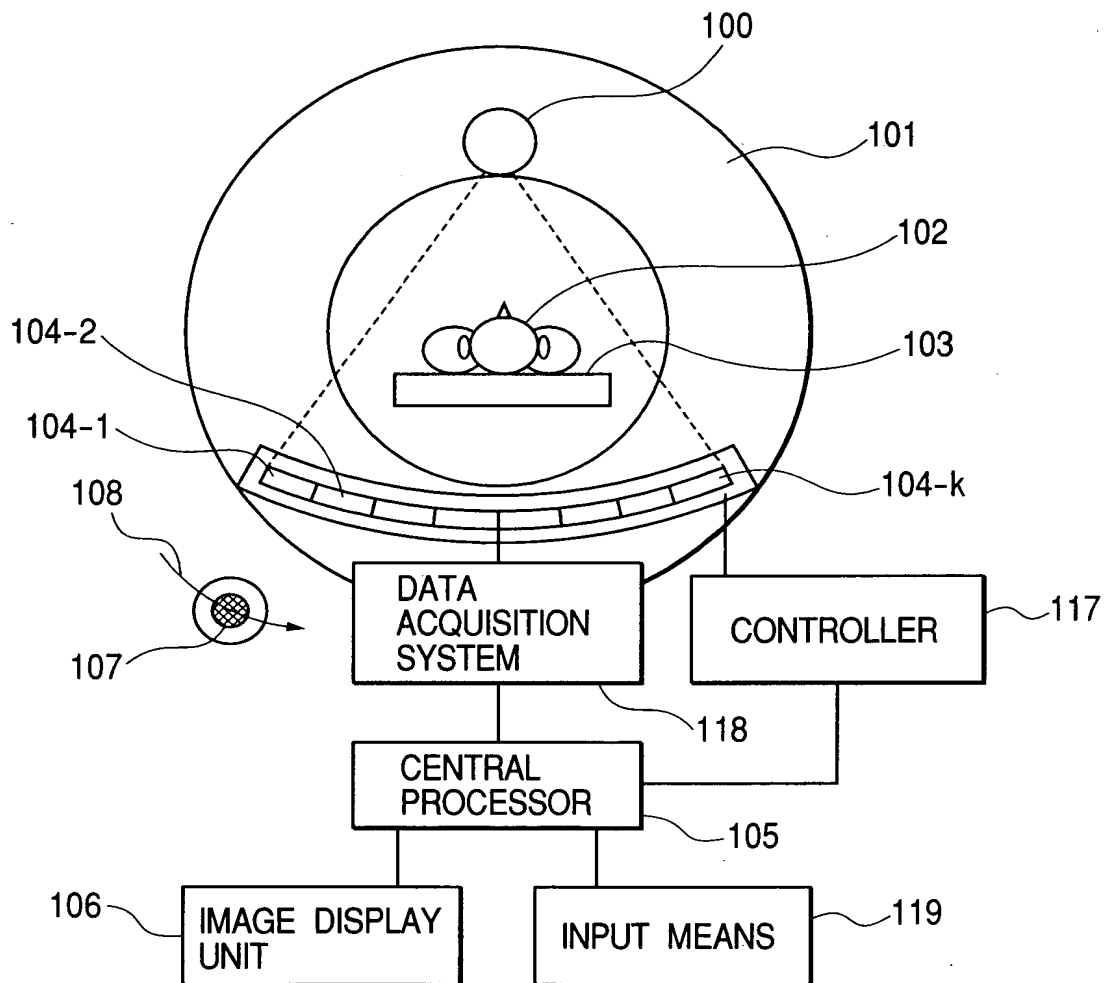
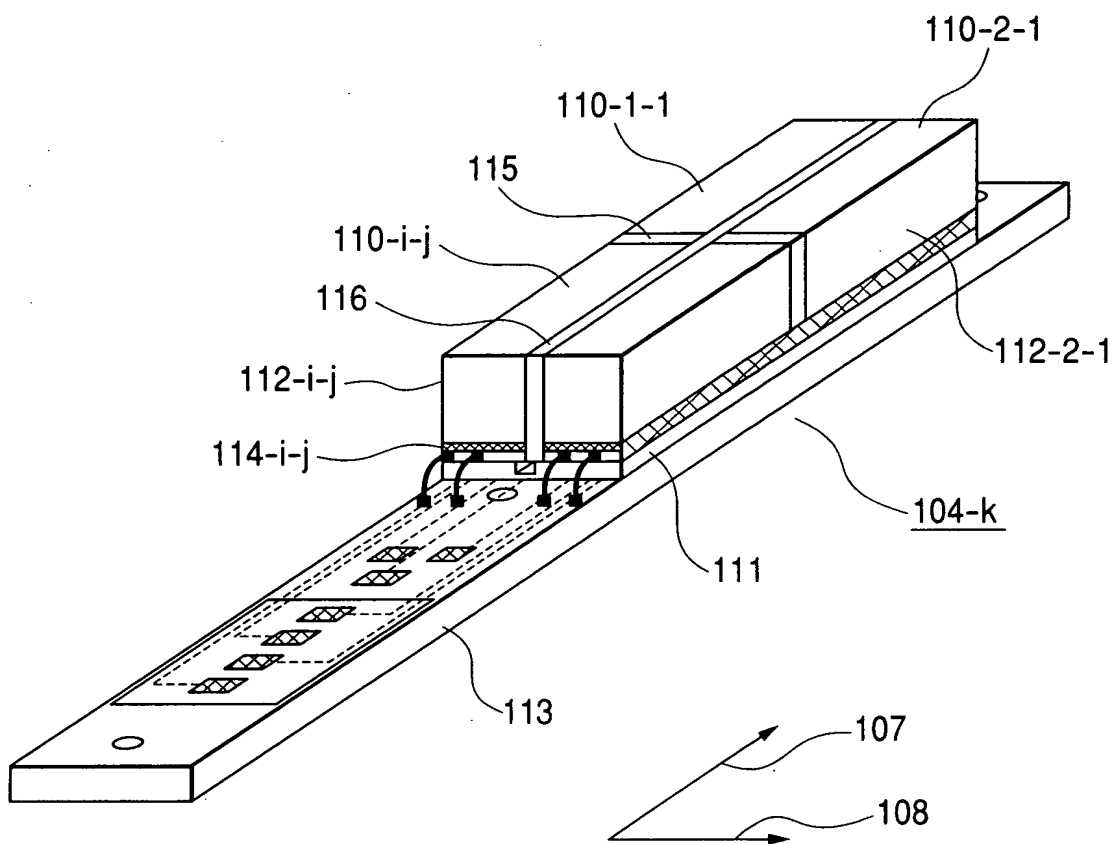




FIG. 3 (PRIOR ART)





SKETCH

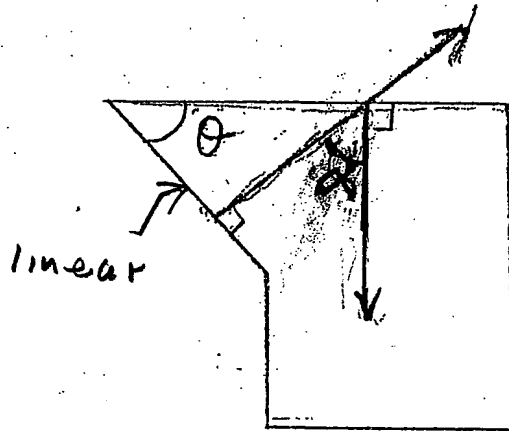


Fig. 7

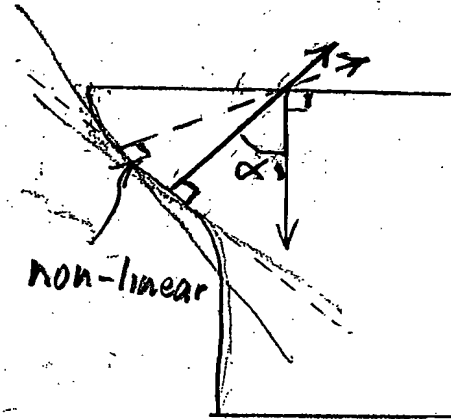


Fig. 15